



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/643,987 | 08/20/2003 | Marybeth Ahern | 00240293US | 5154 |
| 7590 09/11/2008 | | | | |
| Andrew M. Calderon Greenblum and Bernstein P.L.C. 1950 Roland Clarke Place Reston, VA 20191 | | | | |
| EXAMINER | | | | |
| KARDOS, NEIL R | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3623 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 09/11/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/643,987

Applicant(s)

AHERN ET AL.

Examiner

Neil R. Kardos

Art Unit

3623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623

Continuation of 11. does NOT place the application in condition for allowance because: The grounds of rejection set forth in the Final Office Action dated 7/9/2008 stand. Applicant argues the following:

(A) Ann does not teach partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another. Regarding this argument, Examiner respectfully disagrees. Figure 5 of Ann very clearly discloses this limitation. Figure 5 depicts categories of information (e.g. strategic directions, capabilities, principles, processes, roles, responsibilities, organization units, resources, etc.) that are related to one another (as depicted by the arrows in figure 5). Applicant's own specification discusses categories that are the same as those disclosed by Ann (see e.g. abstract, disclosing categories of goals, capabilities, and resources). Thus, Ann teaches partitioning information into related categories. It is also clear from the disclosure of Ann that the partitioned information is relevant to enterprise decision making for evolutionary change (see e.g. abstract, disclosing determining the impact of a change in one category on the other categories). Thus, Ann teaches this limitation.

(B) Ann does not teach automating the management of the categories of the information by an automation system. Regarding this argument, Examiner respectfully disagrees. In paragraph 32, Ann discloses governance rules that govern architecture framework management. Governance rules are set up to automatically determine the impact that a change in one category has on other categories (see abstract). Furthermore, Examiner notes that claim 1 was rejected under § 103, and it would certainly have been obvious to one of ordinary skill in the art to automate category management as claimed. See in re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, this limitation is taught by Ann; even if it were not, the limitation is still obvious under § 103.

Thus, the grounds of rejection set forth in the previous Office Action stand.